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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/938,342      | 08/24/2001  | Dirk Inze            | 2283/402            | 1984             |

7590

01/27/2003

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EXAMINER

COLLINS, CYNTHIA E

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 01/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/938,342

Applicant(s)

INZE ET AL.

Examiner

Cynthia Collins

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133)
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved or b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 and 3, drawn to a method for modulating endoreduplication in a plant by modifying expression or activity of E2Fa, classified in class 800, subclass 260, for example.
- II. Claims 2 and 4, drawn to a method for modulating endoreduplication in a plant by modifying expression or activity of E2Fa and DPa, classified in class 800, subclass 278, for example.
- III. Claims 5, 8, 11, 14, 17 and 20, drawn to a plant cell which overexpresses a native E2Fa gene, a plant or part thereof comprising said plant cells, progeny and plant material, classified in class 435, subclass 410, for example.
- IV. Claims 6, 9, 12, 15, 18 and 21, drawn to a transgenic plant cell comprising an E2Fa transgene, a plant or part thereof comprising said plant cells, progeny and plant material, classified in class 435, subclass 419, for example.
- V. Claims 7, 10, 13, 16, 19 and 22, drawn to a plant cell which overexpresses a native E2Fa gene and a native DPa gene, a plant or part thereof comprising said plant cells, progeny and plant material, classified in class 435, subclass 417, for example.
- VI. Claims 7, 10, 13, 16, 19 and 22, drawn to a plant cell which overexpresses an E2Fa transgene and a DPa transgene, a plant or part thereof comprising said plant

cells, progeny and plant material, classified in class 435, subclass 419, for example.

VII. Claims 7, 10, 13, 16, 19 and 22, drawn to a plant cell which overexpresses an E2Fa transgene and a native DPa gene, a plant or part thereof comprising said plant cells, progeny and plant material, classified in class 800, subclass 298, for example.

VIII. Claims 7, 10, 13, 16, 19 and 22, drawn to a plant cell which overexpresses a native E2Fa gene and a DPa transgene, a plant or part thereof comprising said plant cells, progeny and plant material, classified in class 800, subclass 317.2, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. The method of Invention II requires modifying the expression or activity of DPa, which is not required to practice the method of Invention I.

Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process. The plant cell that

overexpresses a native E2Fa gene of Invention III can be made by another and materially different process, such as a method of plant breeding.

Inventions II and each of V, VII and VIII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process. The plant cell which overexpresses a native E2Fa gene and a native DPa gene of Invention V, can be made by another and materially different process, such as by chemical mutagenesis. The plant cell which overexpresses an E2Fa transgene and a native DPa gene of Invention VII, can be made by another and materially different process, such as a method that combines plant breeding and plant transformation. The plant cell which overexpresses a native E2Fa gene and a DPa transgene of Invention VIII, can be made by another and materially different process, such as a method that combines chemical mutagenesis and plant transformation.

Inventions I, II, III and V and each of Inventions IV and VI-VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions different modes of operation. Each of Inventions IV and VI-VIII requires transformation methods and transgenes not required by Inventions I, II, III and V. Inventions I, II, III and V involve breeding or mutagenesis methods not required by each of Inventions IV and VI-VIII.

Inventions IV and VII and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions different modes of operation. Inventions IV and VII require an E2Fa transgene not required by Invention VIII.

Inventions VI and VIII and IV-V and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions different modes of operation. Inventions VI and VIII require a DPa transgene not required by Inventions IV-V and VII.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter, and the requirement for different areas of search, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

**Remarks**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (703) 605-1210. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

CC  
January 23, 2003

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 1638

*[Handwritten signature]*